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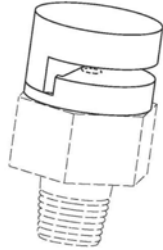
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78867933
Applicant	UDOR U.S.A., INC.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Serial No. 78/867933

Applicant: UDOR U.S.A., Inc.



Mark:

The mark consists of round disk head on sprayer nozzle.

Filing Date: April 24, 2006

Law Office: 114

Examining Attorney: Shaila E. Settles

Attorney Docket No. 1325.8-US-01

APPLICANT'S REBUTAL BRIEF
TO EXAMINER'S REPLY

The Examining Attorney has filed a reply to Applicant's brief. As a matter of right, Applicant is permitted to reply to issues specifically raised in Examining Attorney's brief. Applicant replies specifically to such new issues as succinctly as possible.

Functionality and the role of a utility patent

The Examining Attorney (hereinafter EA) has asserted that the existence of US Patent No. 7,108,204 proves that the asserted trademark is functional and barred from trademark protection and thus the burden of proof of "non" functionality now falls on

Applicant. This assertion is based on a misapplication of the *Traffix* doctrine (*TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001)) and more importantly, the meaning of the term “patent claim”.

We have already argued the *Traffix* doctrine, and therefore focus on the substance of the claims of US Patent 7,108,204 (the ‘204 patent).

New arguments presented by the EA:

The EA asserts that the claims of the ‘204 patent claim the trademark because

- a. Claim 6 refers to a “spray head”. Response: “spray head” does not define a particular structure and thus cannot be considered to have claimed the shape of the trademark.
- b. Various figures show the trademark. Response: the figures are not the claims and under the *Traffix* doctrine are not covered by a utility patent.
- c. The discharge surface is claimed (Reply Brief page 9). Response: the discharge surface is element 4 and if it has any functional aspect, it is deep within the nozzle adjacent the impingement surface 5 and not any portion visible in the trademark drawing. *Compare the trademark drawing to Figure 1 of the ‘204 patent and notice that the internal functional elements have been removed from the trademark drawing.*
- d. The impingement surface is claimed. (Reply Brief page 9) Response: the impingement surface is element 5 and is not visible in the trademark drawing.
- e. The impingement angle is claimed (Reply Brief page 9-10). Response: the impingement angle is element 16 and is not visible in the trademark drawing.

- f. The deflection ridge in figure 1 is element 7 in the '204 patent and the EA argues that, "Although the deflection ridge in Figure 1 contains a filleted corner and sharp corner that intersect at an angle, the area of spray nozzle head immediately behind Reference no. 7 would serve the same overall function as the deflection ridge in figure 1...The equivalent of this area is shown in the proposed configuration trademark.." (Reply Brief page 11). Response: the argument speaks for itself. The EA essentially argues that, although the claimed is not shown in the trademark drawing it has the same function as some element which is shown. There is no factual or scientific basis for this assertion, but in any case, it is indeed not claimed, and whether some other non-claimed component could function or not in the same way, is well beyond the scope of the question before this Tribunal. *The EA is asking for the functional features of the patent to be moved so that they can be found in the trademark drawing.* The question is merely: is the claimed element shown in the trademark drawing. It is not.
- g. Even though none of these elements are shown in the trademark drawing,"... fluid exiting the orifice would still impact the surface oppositely facing the orifice in the proposed trademark causing it to form an impingement flow striking that surface and ultimately creating a fluid plume or flat fan flow much the way water disperses from a garden hose..." (Reply Brief page 11) Response: Actually, this is totally irrelevant to the question of what is claimed, but more precisely, if the EA wishes to assert the truth of this rebutting statement, it is necessary for the EA to have some factual or scientific basis for the assertion. There is none and there is no affidavit of the EA asserting particular competency

of a person skilled in the art of fluid dynamics. More to the point however, is that the claims control the *Traffix* doctrine and the claims do not recite structures which are visible in the trademark drawings.

- h. The prior art cited in the prosecution of the '204 patent supports the conclusion that the design is functional and that it has shifted the burden of proving functionality to the Applicant (Reply Brief page 13).

Response: The prior art cited is to meet the requirement of 37 C.F.R. 1.56 (duty of disclosure). No functionality conclusion can be reasonable drawn from the EA's assertion. In general it is easier to prove functionality than the opposite. Thus, the Office should have the easier case, but cobbling to statements which are non sequiturs together and calling it "meeting the burden of proof" hardly even scratches the surfaces of the burden. The submission of prior art in a patent case leads nowhere in a trademark functionality analysis.

- i. "The evidence of record simply does not address the issue of how or why the spray nozzle head, the spray nozzle body, the discharge surface, the impingement surfaces ...and the deflection ridge are non functional" (Reply Brief page 16). Response: the Applicant does not have to prove non-functionality. Furthermore, the Applicant does not have to prove anything with respect to features which are hidden from view (discharge surface, impingement surfaces, deflection ridges) and not part of the trademark drawing or which are only described in a general sense (nozzle body , nozzle head) without specific form. Otherwise, no object, matter how unique and non-functional could ever form the basis of a configuration trademark. Under the EA's theory of law, a Coca Cola ® bottle trademark for its specific shape would be rendered incapable of

trademark protection by a patent which had as an element of its invention the words “a bottle”. This would be an absurd result.

- j. The assertion of the lack of “boom arm” in advertising renders the trademark functional (Reply Brief 17). Response: A boom arm is something that nozzles are connected to in order to extend their reach. The (hidden and claimed parts of this) nozzle eliminates the need for a boom arm in many cases. No functionality conclusion can be logically drawn to the trademark drawing.

Arguments Concerning Acquired Distinctiveness

The EA has argued that the evidence in support of acquired distinctiveness is insufficient.

The affidavit under Section 2(f) is summarily dismissed by the EA, because the EA asserts that the mark is functional and no amount of use can overcome that assertion. We have demonstrated that the mark is not functional and not claimed in a patent. The EA’s assertion that the Section 2(f) claim fails is thus unsupported by valid argument or evidence.

Still, there is other evidence in the record, which is also dismissed by the EA, but based on conjectural statements, without support. For example, there is evidence of record that Applicant has approximately 33% of the market, \$2 million in sales, over 80,000 nozzles sold, \$150,000 in advertising spent, which in a splintered industry, is quite significant. Continuous use for 7 years by a one-third market share company cannot be dismissed by a mere statement of the EA. A basis must be provided as to why such use would not ordinarily result in acquired distinctiveness. The mere assertion that it does not, is wholly inadequate.

The evidence presented is taken from a sampling of buyers of the product. The buyers and the relevant “public” as the product is purchased entirely by resellers for further distribution. The “public” is thus the reseller community, which for this product, is very small.

The EA asserts that the “pubic” are farmers or similar agri-businesses. This is not supported by any evidence of record. The evidence of record is that of the “public” being resellers, and to that end, the Applicant has made a reasonable effort, in view of the volume of sales overall, to provide actual evidence of acquired distinctiveness.

Conclusion

This rebuttal brief clearly demonstrates that the EA’s analysis of patent law and patent claims is fatally flawed. Furthermore, the EA’s use of faulty fluid dynamics arguments is wholly unsupported by any evidence or even science.

The problem presented is really very simple. Imagine a telephone set inside of a phone booth. The fact that a telephone set is the subject of a patent claims does not render the phone booth functional or disqualified under the *Traffix* doctrine. Here the functional claimed features of the nozzle are hidden from view and not shown in the trademark drawing. It is that simple.

The Applicant has made a reasonable showing of acquired distinctiveness in view of the esoteric nature of the marketplace in which the product is sold. The examiner attempts to recast the relevant public to an entirely different group of people who normally have no say in the selection of nozzles because they are already built into larger machines. The relevant public has been sampled and furthermore the product has been in continuous use for approximately seven years and is a sales leader.

Ample argument has been presented in favor of the Applicant's position. The application should be published for opposition.

Respectfully submitted,

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